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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/807,213	03/22/2004	Chun Ta Lee		3301

25859 7590 10/16/2006
WEI TE CHUNG
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EXAMINER

FIGUEROA, FELIX O

ART UNIT PAPER NUMBER

2833

DATE MAILED: 10/16/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/807,213

Applicant(s)

LEE ET AL.

Examiner

Felix O. Figueroa

Art Unit

2833

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 August 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 and 16-20 is/are pending in the application.
- 4a) Of the above claim(s) 16-20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 16-20 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

Newly submitted claims 16-20 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons:

Inventions I (claims 1-7) and II (claims 16-20) are related as mutually exclusive species in an intermediate and final product relationship. Distinctness is proven for claims in this relationship if the intermediate product is useful to make other than the final product, and the species are patentably distinct (MPEP § 806.05(j)). In the instant case, the intermediate product is deemed to be useful as a bridge / short-circuit element; and the inventions are deemed patentably distinct because there is nothing on this record to show them to be obvious variants.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 9-15 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Claim Objections

Claims 2 and 3 are objected to because of the following informalities:

In claim 2 line 5, --section-- should be added after "second contact".

In claim 3 line 5, --shape-- should be added after "semicircular".

Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1 and 7 are rejected under 35 U.S.C. 102(b) as being anticipated by Pernet (US 5,860,821).

Pernet discloses a switching terminal comprising: a carrier strip (2); a first terminal (5) extending from an edge of the carrier strip comprising a first base section (adjacent carrier 2) and a first contact section (at 22) and extending perpendicularly from the base section; and a second terminal (4) extending from the edge of the carrier strip, being substantially parallel to the first base section of the first terminal and having a cutout defined in an edge (in right edge); a second contact section (at 8) formed on one end of the second terminal being displaced out of the plane of the first terminal (see Fig.2a). Regarding the recitation "to absorb distortion", please note that a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

Regarding claim 7, Pernet discloses a plurality of terminals connected with the carrier strip and parallel to the first terminal.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

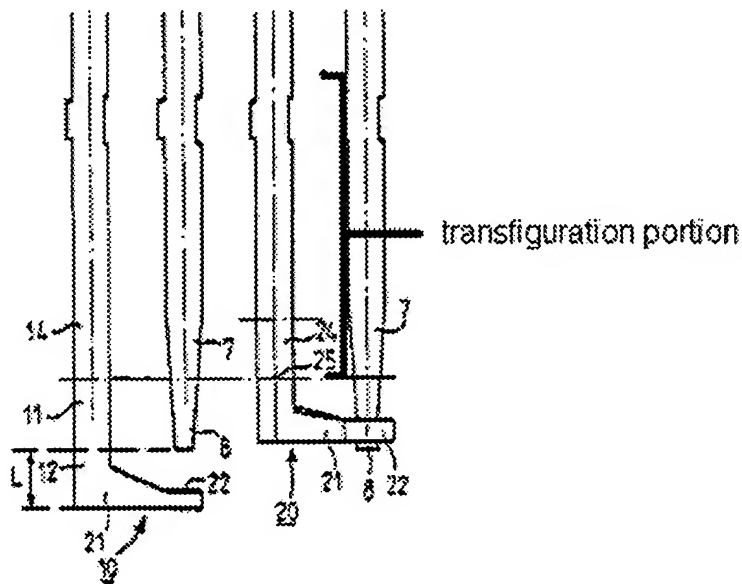
Claims 2-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pernet.

Pernet discloses substantially the claimed invention except for the pressing portion in arc configuration formed on the first terminal instead of the second terminal. It would have been obvious to one having ordinary skill in the art at the time the invention was made to form the second terminal including the pressing portion with the arc configuration in order to simplify the construction of the first terminal, and since it has been held that rearranging parts of an invention involves only routine skill in the art. *In re Japikse*, 86 USPQ 70.

Regarding claim 3, Pernet discloses the second terminal comprises a second retaining portion connecting with the carrier strip, the cut out being on an edge adjacent to the first terminal (please note that the outer edge is still "adjacent"). Pernet discloses substantially the claimed invention except for the shape of the cutout. However, it would have been an obvious matter of design choice to form the cutout with a semicircular shape in order to simplify formation of the cutout, and since applicant has not disclosed that such shape solves any stated problem or is for any particular purpose and it appears that the invention would perform equally well with shape of Pernet.

Absent any convincing showing of the criticality of the design, this particular design is nothing more than the inventor's choice without thereby departing from the scope of the invention. *In re Dailey*, 149 USPQ 47 (CCPA 1976).

Regarding claim 4, Pernet discloses the second base section comprises a transfiguration portion (part at 24, see following figure), and an angled portion (at 21) interconnecting the transfiguration portion and the pressing portion.



Regarding claim 5, Pernet discloses the cut out being defined in the transfiguration portion (see previous figure).

Regarding claim 6, Pernet discloses the transfiguration portion being deflected outwardly (left in Fig.2b-1) for the position of the cut out.

Response to Arguments

Applicant's arguments filed 08/28/2006 have been fully considered but they are not persuasive.


In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., the first terminal being formed in one plane) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Please note that claim 1 only requires "a first contact section formed in a first plane".

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Felix O. Figueroa whose telephone number is (571) 272-2003. The examiner can normally be reached on Mon.-Fri., 10:00am-6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paula A. Bradley can be reached on (571) 272-2800 Ext. 33. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


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Art Unit 2833